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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,913	11/21/2003	Nobuo Ichimura	062709-0118	7376
22428	7590	11/28/2005	EXAMINER	
FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			BOCHNA, DAVID	
			ART UNIT	PAPER NUMBER
			3679	

DATE MAILED: 11/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/717,913	<b>Applicant(s)</b> ICHIMURA ET AL.	
	<b>Examiner</b> David E. Bochna	<b>Art Unit</b> 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2005.  
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.  
 4a) Of the above claim(s) 5-12 is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-4 and 13-15 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☒ All b) ☐ Some \* c) ☐ None of:  
 1. ☒ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 1, it is unclear how the second member can both have a blade portion and also engage the stepped portion of the first member. Looking at fig. 1A-1B it can be seen that the blade 41 never contacts the stepped portion 24, only member 31 contacts this stepped portion.

Additionally, the preamble of claim 1 recites a structure for connecting a first member and a second member. Looking at figs. 1A-1B it can be seen that the blade portion (the second member as labeled by the Applicant) is not connected to the first member (21), it is only used to facilitate a connection between members 30 and 21. Therefore it is unclear how the member 40 can be considered a "second member" in the claimed structure when member 40 is not connected to the first member 21.

For purposes of examination, member 30 is considered by the Examiner to be the "second member" because claim 1 states that the stepped portion is engaged by the second member and member 30 contacts the stepped portion where member 40 with the blade portion 41 never contacts portion 24, as shown in figs. 1A-1B.

*Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilson et al.

In regard to claim 1, Wilson et al. discloses a structure for a first member and a second member, comprising:

a first member 20 having a peripheral wall portion including a stepped portion 62 engaged with a second member 28, the peripheral wall portion being a deformed portion 74 deformed inwardly of the stepped portion 62 of the first member, the deformed portion 74 having a thin shape provided by a cut section of the peripheral wall portion.

The limitations “wherein the deformed portion is formed by a cut performed by the blade portion, and wherein the blade portion includes an inclined face portion that is recessed with a curvature” is considered a product by process limitation and is given little patentable weight because the claimed invention is drawn only to “a structure for connecting a first member and a second member”. The connecting structure is the deformed portion, not the tool that the produces the structure. Therefore the process of using a cutting tool with a curved cutting blade is given little patentable weight.

In regard to claim 2, Wilson et al. discloses a connecting structure of a pipe connected to a passage formed in a member, comprising:

a projection portion 42 provided so as to project from the pipe radially and outwardly;

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a recess portion 56 provided at an open end of the passage formed in the member and receiving the projection portion of the pipe; and

a peripheral wall 74 portion engaged with the projection portion by bending and deforming the peripheral wall portion inwardly of the recess portion while cutting the peripheral wall portion in a thin shape at a distance from the recess portion so that the pipe inserted into the opening end of the passage in the member and the projection portion of the pipe has been received in the recess portion are connected.

The limitations “wherein the peripheral wall portion is deformed by a cut performed by the blade portion, and wherein the blade portion includes an inclined face portion that is recessed with a curvature” is considered a product by process limitation and is given little patentable weight because the claimed invention is drawn only to “a connecting structure for connecting a first member and a second member”. The connecting structure is the deformed portion, not the tool that produces the structure. Therefore the process of using a cutting tool with a curved cutting blade is given little patentable weight.

In regard to claim 3, wherein the projection portion 42 is formed in an annular shape on an outer periphery of the pipe, the recess portion is formed in an annular shape on an outer periphery of the passage in the member, and the peripheral wall portion 74 is deformed inwardly in a continuous annular shape.

5. Claims 2, 4 and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Gaitros et al.

In regard to claim 2, Gaitros et al. discloses a connecting structure of a pipe connected to a passage formed in a member, comprising:

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a projection portion 4 provided so as to project from the pipe radially and outwardly;  
a recess portion 6 provided at an open end of the passage formed in the member and receiving the projection portion of the pipe; and

a peripheral wall portion 8 engaged with the projection portion by bending and deforming the peripheral wall portion inwardly of the recess portion while cutting the peripheral wall portion in a thin shape at a distance from the recess portion so that the pipe inserted into the opening end of the passage in the member and the projection portion of the pipe has been received in the recess portion are connected.

The limitations “wherein the peripheral wall portion is deformed by a cut performed by the blade portion, and wherein the blade portion includes an inclined face portion that is recessed with a curvature” and the limitations to the cutting blade in claims 13-15 are considered product by process limitations and are given little patentable weight because the claimed invention is drawn only to “a connecting structure for connecting a first member and a second member”. The connecting structure is the deformed portion, not the tool that produces the structure. Therefore the process of using a cutting tool with a curved cutting blade is given little patentable weight.

In regard to claim 4, wherein the projection portion is formed in an annular shape on an outer periphery of the pipe,

the recess portion is formed in an annular shape on an outer periphery of the passage in the member, and

the peripheral wall portion is bent and deformed inwardly at intermittent sections in a circumferential direction (see figs 6-8).

*Response to Arguments*

6. Applicant's arguments have been fully considered but they are not persuasive. The limitations drawn to the structure of the cutting blade are given no patentable weight because the claims are drawn to a connecting structure (the deformed portion) and not to a cutting tool or a process of deforming the first member. Therefore the prior art rejections have been maintained.

*Conclusion*

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

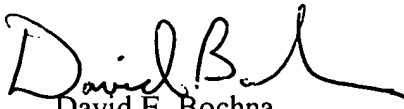
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Bochna whose telephone number is (571) 272-7078. The examiner can normally be reached on 8-5:30 Monday-Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
David E. Bochna  
Primary Examiner  
Art Unit 3679